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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,423	04/25/2001	Michael D. Jenkins	X0104E	9325

7590 03/30/2004  
JAMES J. RALABATE  
5792 MAIN STREET  
WILLIAMSVILLE, NY 14221

EXAMINER
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LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 03/30/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/843,423

Applicant(s)

JENKINS ET AL.

Examiner

Ming-Hun Liu

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2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,486,875 to O'Donnell.

In reference to claims 1 and 14, O'Donnell teaches a wireless pen shaped input device that includes a microphone (column 4, lines 57-61 and figure 1, item 33), a power supply (item 24), a wireless transmitter (column 4, lines 42-43) and at least one removable function module (column 3, lines 16-18). From figure 1, it is apparent that the wireless transmitter (item 27) is housed in the body of the device. O'Donnell's microphone and speaker allows communication and voice commands (column 3, lines 18-21) which inherently would include a speech processing circuit.

O'Donnell however does not teach the addition of a pocket clip to the pen. Adding a pocket clip to writing instruments is extremely conventional to the point of nearly being inherent to the pen art. Nevertheless, one skilled in the art would have added a pocket clip to the pen so that the slim device can be comfortably secured to articles of clothes.

Claim 5 is rejected largely on the grounds offered in the rejection of claims 1 and 14. O'Donnell discloses an input mouse pen device that is very similar to the invention being claimed. However, O'Donnell's invention lacks two features in his pens invention that sets his invention apart from the claimed invention. Particularly, O'Donnell's fails to disclose the use of a rechargeable battery and the incorporation of an external button.

As for the rechargeable battery feature, O'Donnell does teach the use of a battery, however he does not explicitly state that the battery be of rechargeable type. As one skilled in the art understands, rechargeable batteries are commonly found in electronic devices, in particular high-end portable wireless devices. O'Donnell's invention could have been easily modified to resemble the claimed invention by switching his battery with a battery with recharging capabilities. It would have been obvious to one skilled in the art to use a rechargeable battery for a wireless pen device, to develop a more environmentally safe, convenient and easy to maintain device.

In regards to the addition of an external button, as one skilled to the art understands, button on the exterior of electronic pointing devices are extremely common if not an inherent feature to the mouse. One skilled in the art would have added a button to O'Donnell's pen device to serve as a selection button, a feature that is readily found on the mouse. It would have been obvious to add a button to the pen device to more accurately resemble the functionality of the mouse.

Claim 18 is rejected on grounds offered in the rejection of claim 5.

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3. Claims 3, 10-13 and 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell in view of US Patent 1,523,753 to Chen and also in view of US Patent 5,343,376 to Huang.

In reference to claims 3, 10-13 and 16, O'Donnell's invention includes a roller ball type material that dispenses ink (see figure 1, item 13 and column2, lines 58-61).

O'Donnell's invention is missing is the incorporation of a laser pointer module. As one skilled in the art understands laser pointers on pen-like devices are extremely conventional. This idea has been known to the art as early as 1994. One skilled in the art would have been motivated to add a laser pointer to this pen device so that users can point to objects on display screens when using the pen device to control the computer displayed contents.

O'Donnell's disclosure also does not discuss the possibility of incorporating a lead pencil function. But as one skilled in the pen art understands combinational pen/pencil writing instruments have been available for a long time now (since 1925, Chen). Adding this function to a pen device is not considered novel, as this feature allows users to switch between specific writing styles when desired.

4. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of O'Donnell and US Patent 6,199,292 to Ebeling.

In reference to claims 4 and 17, O'Donnell's invention is very similar to the one being claimed; however O'Donnell does not teach the dual purpose of having the antenna as the clip. Ebeling on the other hand, does teach a wireless pen device that utilizes the antenna as a clip. Ebeling writes on column 5, lines 2-5 that the "antenna is formed into a clip, as illustrated in

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figure 2A, which permits the pen shaped dimensioning device 30 to be attached to a shirt pocket”.

5. Claims 2, 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell in view of US patent 6,380,930 to Van Ruymbeke.

In reference to claims 2, 6 and 15, O'Donnell teaches the use of wireless data transmission, however he does not specifically single out the use of Bluetooth technology. On column 4, lines 42-44, O'Donnell states that “a wireless computer connector also is included in pen. Connector can be any acceptable technology.” O'Donnell understands that RF is not the only wireless transmission alternative and leaves the particulars of the wireless transmission to these familiar to the art.

As Van Ruymbeke explains in the background of his invention, Bluetooth is a “universal wireless interface” between computer devices (column 1, lines 28-34). Naturally, one skilled in the art would utilize Bluetooth transfer communicators to assist with the portability of this pen device from system to system. As it is well known in the art, Bluetooth modules are readily available and are commonly used for wireless data transmission.

6. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Donnell in view of US patent 5,777,571 to Chaung.

O'Donnell on column 3, lines 19-21 teaches the use of a microphone to allow voice input commands. He however does not go into detail about the circuitry inside that allows for the voice input. The components listed in the claims 7-9 are standard if not inherent to the digital

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voice recognition/command circuit art. As one skilled in the art understands and clearly exemplified in Chaung's patent (abstract), a voice command circuit requires an A/D converter and processing unit and a buffer for proper functionality.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


US Patent 4,969,180 to Watterson et al.: A pen device with voice features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu

  
DENNIS-DOON CHOW  
PRIMARY EXAMINER